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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,089	02/26/2002	Hitoshi Takayanagi	020232	8614

23850 7590 11/28/2003

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EXAMINER

NOTE, JANIS L

ART UNIT PAPER NUMBER

1756

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 10/082,089	Applicant(s) TAKAYANAGI ET AL.	
	Examiner Janis L. Dote	Art Unit 1756	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see Note below);

(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached, paragraph 1.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached, paragraph 2.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-4 and 6-11.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.

10. ☒ Other: attached

JANIS L. DOTE
 PRIMARY EXAMINER
 GROUP 1756
 1756

1. The amendment to the claims filed in the amendment after the final rejection on Nov. 10, 2003 (Amdt111003) is considered to be non-compliant because it fails to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 Fed. Reg. 38611, Jun. 30, 2003).

Amended claim 9 recites the phrase "dispersing a binder resin" (emphasis added), while the previously amended claim 9, filed on May 27, 2003, recites the phrase "dispersing the binder resin" (emphasis added). Applicants changed the article "the" to the indefinite article -- a --, without the proper markings.

37 CFR 1.121 states that "[t]he text of all claims being currently amended must be presented in the claim listing with markings to indicate the changes that have been made relative to the immediate prior version."

Amended claim 9 filed in Amdt111003 also raises a rejection under 35 U.S.C. 112, second paragraph, for lack of unambiguous antecedent basis because it is not clear whether "a binder resin" recited in claim 9 refers to the binder resin having a carboxyl group recited in claim 8, from which claim 9 depends, or to another binder resin.

2. The examiner's refusal to enter the amendment filed after the final rejection (Amdt111003) renders applicants' arguments

regarding said amendment moot. Thus, the rejection under 35 U.S.C. 112, second paragraph, and the prior art rejection over Ishikawa, set forth in the final rejection mailed on Jul. 10, 2003 (CTFR071003), stand.

Furthermore, the references of Tosaka and Kanbayashi are prior art to the instant application. Applicants have not perfected their claim to foreign priority under 35 U.S.C. 119. The certified English-language translation of the priority document, Japanese patent application Hei 2001-056636, filed on Nov. 10, 2003, does not provide an adequate written description of the subject matter recited in instant claims 1-4 and 6-11, as required under 35 U.S.C. 112, first paragraph. For example:

1) The translation does not disclose the pigments of formulas 3, 4, and 6-9 recited in instant claims 1-4 and 6-11, which are identified by the instant specification as C.I. Pigment Red 150, 31, 176, 187, 188, and 269, respectively. See the instant specification, pages 19-20. Rather, the translation at page 1 discloses the magenta pigment, C.I. Pigment Red 146, which has the formula (1) at page 1 of the translation, which does not meet the pigments recited in instant claim 1. See the instant specification, page 19, lines 4-5, which describes the pigment C.I. Pigment Red 146. The translation at pages 18-20 discloses the pigments C.I. Pigment Red 122, 22, 48:1, 48:3, and 57:1, which are not recited in instant claim 1.

2) The translation does not recite that the "organic pigment is dispersed finely in the binder resin" as required in instant claims 1-4 and 6-11.

3) The translation at page 1 discloses that its toner has an average roundness of 0.97 or more. Instant claims 1, 2, and 6-11 do not require that the color toner have an average roundness of 0.97 or more.

4) The translation does not disclose the average roundness degree of "0.93" recited in instant claim 3. The translation at page 18, lines 6-9, discloses the disadvantages of toners having an average roundness of less than 0.97.

Thus, the subject matter recited in claims 1-4 and 6-11 are not entitled to the benefit of priority under 35 U.S.C. 119. Accordingly, the rejections over Tosaka and Kanbayashi set forth in CTFR071003 stand.